

REMARKS

Claim objections

Claim 9 has been objected to, but this objection is now moot insofar as claim 9 has been cancelled.

Claims 1-11

Claim 1 is an independent claim, from which claims 2-11 depend. Claims 1-11 have been rejected under 35 USC 102(e) as being anticipated by Botham (6,785,812). Claim 1 has been amended to at least substantially recite the subject matter of claims 3 and 9, and claims 3 and 9 have been cancelled. Claim 4 has been amended to depend from claim 1 instead of from now-cancelled claim 3. Applicant submits that as amended, claim 1 is patentable over Botham, such that pending claims 2, 4-8, and 10-11 are patentable at least because they depend from a patentable base independent claim.

It is noted that, under 35 USC 102, every limitation of a claim must *identically* appear in a single prior art reference for it to anticipate the claim. (In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)) That is, the standard for anticipation under 35 USC 102 is that "[t]here must be *no difference* between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." (Scripps Clinic & Research Found. v. Genentech, Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)) The prior art reference must disclose each element of the claimed invention "*arranged as in the claim*" in question. (Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984))

Applicant now discusses in detail two particular limitations of claim 1 as amended that are not found identically in Botham and/or that are not arranged in Botham as in claim 1, such that there is a difference between the claimed invention and Botham.

*Destroying original document only after assurance that system has received transmission*

Claim 1 is limited to “destroying the original document *at the system of the sender* after transmitting the image of the original document to the system of recipient, *where the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document.*” Note the explicit ordering of these two actions. Not only is claim 1 limited to destroying the original document *at the system of the sender* after transmitting the image of the original document to the recipient’s system, claim 1 is specifically and particularly limited to such destruction *only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document.* That is, the action of destroying the original document *at the system of the sender* is explicitly tied in order of performance to the action of the system of the sender receiving assurance that the system of the recipient has received transmission of the image of the original document. The original document is destroyed at the sender’s system only after the sender’s system has been assured that the recipient’s system has received the image of the original document.

Applicant submits that Botham does not disclose this limitation as arranged in the claim in this manner, such that Botham does not anticipate claim 1. The Examiner has indicated that Botham discloses destroying the original document in column 4, lines 9-10 and 34-35. (Office action, p. 3, para. a.i.(2).) The Examiner has further indicated that Botham discloses assuring that the system of the recipient has received transmission the image of the document before destroying the original document in column 2, lines 32-34 and column 4, lines 9-10 and 34-35. (Office action, p. 3, para. c.i.(1).)

Columns 2, line 32-34, and column 4, lines 9-10 and 34-35, of Botham state the following:

The document is delivered securely and to only the intended client.  
Document reception is confirmed by the client via the acknowledgment to the server.

....

Permissions 121 specify what receiving client 101 is entitled to do with document 120. For example, they specify . . . how long document 120 is allowed to “live” (i.e., exist, before automatically destroyed by application 130 [on receiving client 101]) . . . .

Application 130 [on receiving client 101] is charged with enforcing permissions 121 of the document 120 . . . . It [the actions performed by application 130] may also include destroying document 120 once its allotted “lifetime” expires.

In the first instance, therefore, Botham does not disclose destroying the original document *at the system of the sender*, to which claim 1 is limited. Rather, Botham discloses destroying the original document *at the system of the recipient* – the receiving client 101. Thus, once a document has been received by the receiving client 101, the document has a “lifetime” at which it is allowed to remain on the receiving client 101. Once this lifetime has expired, the application 130 on the receiving client 101 automatically destroys the document. Because Botham does not disclose destroying the original document at the system of the sender, as in claim 1, Botham does not anticipate claim 1. That is, Botham does not disclose the identical invention of claim 1.

In the second instance, Botham does not actually destroy the original document *only after* the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document. In the claimed invention, the destruction of the original document at the system of the sender is explicitly tied to the sender’s system having received assurance that the recipient’s system has received transmission of the image of the original document. By comparison, there is no such explicit relationship in Botham; that is, Botham does not disclose these two actions “arranged as in the claim.” More specifically, once the lifetime of the document has expired at the receiving client 101, the document is automatically destroyed, period. It does not matter whether the sender’s system has received assurance that the receiving client 101 has actually received the image of the document – that is, whether the sender’s system has received such assurance is immaterial and irrelevant to the destruction of the document; only whether the lifetime of the document has expired is material and relevant to the

destruction of the document. Because such assurance is explicitly related to whether the document is destroyed in claim 1, and because such assurance is completely irrelevant to whether the document is destroyed in Botham, Botham does not anticipate claim 1. Botham does not disclose the limitations of claim 1 “arranged as in the claim.”

*Public notary notarizing a copy of the image of the original document printed*

Claim 1 is limited to certifying that the copy of the image of the original document was received from the sender “by at least a *public notary notarizing* the copy of the image of the original document *as has been printed*.” To understand this limitation of claim 1, it is important to understand what a “public notary” (i.e., a “notary public”) ordinarily and customarily means, and what “notarizing” ordinarily and customarily means, to one of ordinary skill within the art. The web page [en.wikipedia.org/wiki/Notary\\_public](http://en.wikipedia.org/wiki/Notary_public) provides good information in this respect. It states that a “notary public is an officer who can administer oaths and statutory declarations, witness and authenticate documents and perform certain other acts varying from jurisdiction to jurisdiction.” As such, “[d]ocuments certified by notaries are sealed with the notary's seal or stamp,” and may be “recorded by the notary in a register (also called a 'protocol') maintained and permanently kept by him or her.” The online dictionary [www.dictionary.com](http://www.dictionary.com) further accurately defines a notary public as meaning a “person legally empowered to witness and certify the validity of documents.”

In this way, notarizing a document means that a public notary has certified that the document is authentic. The web page [en.wikipedia.org/wiki/Certified\\_copy](http://en.wikipedia.org/wiki/Certified_copy) also provides good information in this respect. “A certified copy is a photocopy of a filed document, legal or other, in its entirety (everything within a staple) that is sworn to be a true copy.” Furthermore, “[s]ome states in the United States permit notaries public to certify copies.” The online dictionary [www.dictionary.com](http://www.dictionary.com) further accurately defines notarize as meaning “to certify (a document, contract, etc.) or cause to become certified through a notary public.” It is noted that the patent

application as filed is consistent with these customary and ordinary definitions of notary public and notarizing. (See, e.g., p. 2, l. 27, through p. 3, l. 33.)

Applicant submits that Botham does not disclose this limitation of claim 1 – where this claim is properly constructed and interpreted as has been discussed above – such that Botham does not anticipate claim 1. The Examiner has indicated that Botham discloses notarizing the copy of the image of the document (i.e., as received by the recipient's system) as has been printed in column 4, lines 10-18. (Office action, p. 4, para. i.i.(1).) This excerpt of Botham reads as follows:

[S]erver 102 signs a document 120 with a unique signature 122, e.g., appends a unique serial number thereto, at step 218. . . . Server 102 then sends the encoded document 120 to client 101, at step 224.

In the first instance, it is noted that claim 1 is specifically limited to certifying that the copy of the image of the original document was received from the sender by at least a public notary notarizing the copy of the image of the original document as has been printed. By comparison, in Botham, the sending server 102 signs the document 120 with a unique signature 122 in step 218 before even the server 102 even sends the document 120 to the receiving client 101. Therefore, inasmuch as such signing of the document 120 could even be said to correspond to notarizing the document, this signing is not part of certifying that the copy of the image of the original document was received from the sender (i.e., by the recipient), as in claim 1, because the signing of the Botham takes place *before the document is even sent by the sender*. Thus, Botham does not anticipate claim 1. Specifically, Botham does not disclose the limitations of claim 1 “arranged as in the claim,” where in claim 1 notarizing is part of certifying that the copy of the image of the document has been received from the sender, and where in Botham signing is *not* part of certifying that the document has been received from the sender.

In the second instance, claim 1 is specifically limited to a “public notary notarizing the copy of the image of the original document as has been printed.” By comparison, in Botham, a sending server 102 signs the document 120 with a unique signature. It is readily apparent that

Botham does not disclose this particular limitation of claim 1. A public notary, as has been discussed above, is a *person* – an officer. A server, by comparison, is simply a computer. Notarization is a very particular legal process. A server simply signing a document is not a legal process at all, and is definitely not the legal process of notarization. It is further noted that claim 1 is limited to notarizing a copy of the image of the original document *as has been printed*. By comparison, insofar as the server in Botham adds a signature to a document before electronically sending the document to a receiving client, this signature is inherently added to an *electronic* copy of the document – not a *printed* copy of the document, as in the invention. Botham thus does not anticipate claim 1. That is, Botham does not disclose the identical invention of claim 1.

#### Claims 12-18

Without prejudice, Applicant has cancelled claims 12-18, rendering the rejection of these claims moot.

#### Claims 19-22

Claim 19 is an independent claim, from which claims 20-22 ultimately depend. Claims 19-22 have been rejected under 35 USC 102(e) as being anticipated by Botham. Applicant submits that as amended, claim 19 is patentable over Botham, such that claims 20-22 are patentable at least because they depend from a patentable base independent claim.

Claim 19 includes the limitation “wherein the original document is destroyed at the imaging apparatus only after the imaging apparatus has been assured that the recipient has received the copy of the original document.” In this respect, claim 19 is akin to claim 1, which includes a similar limitation. Therefore, claim 19 is patentable over Botham for at least some of the same reasons that have been discussed above in relation to claim 1.

Claims 23-32

Claim 23 is an independent claim, from which claims 24-32 ultimately depend. Claims 23-32 have been rejected under 35 USC 102(e) as being anticipated by Botham. Applicant submits that as amended, claim 23 is patentable over Botham, such that claims 24-32 are patentable at least because they depend from a patentable base independent claim.

Claim 23 includes the limitations of a first public notary notarizing an original document, and a second public notary notarizing a copy of the original document produced at the second imaging device. In this respect, claim 23 is akin to claim 1, which includes similar limitations as to a public notary and notarization. Therefore, claim 23 is patentable over Botham for at least some of the same reasons that have been discussed above in relation to claim 1.

Claims 33-34

Claim 33 is an independent claim, from which claim 34 ultimately depends. Claims 33 and 34 have been rejected under 35 USC 102(e) as being anticipated by Botham. Applicant submits that as amended, claim 33 is patentable over Botham, such that claim 34 is patentable at least because they depend from a patentable base independent claim.

Claim 33 includes the limitation where “the original document is destroyed at the first imaging device only after the first imaging device has been assured that the second imaging device has received the image of the original document.” In this respect, claim 33 is akin to claim 1, which includes a similar limitation. Therefore, claim 33 is patentable over Botham for at least some of the same reasons that have been discussed above in relation to claim 1.

Claims 35-39

Claim 35 is an independent claim, from which claims 36-39 ultimately depend. Claims 35-39 have been rejected under 35 USC 102(e) as being anticipated by Botham. Applicant submits

that as amended, claim 35 is patentable over Botham, such that claims 36-39 are patentable at least because they depend from a patentable base independent claim.

Claim 35 includes the limitation where “the original document is destroyed at the apparatus only after the apparatus has been assured that the image of the original document has been received by the system of the recipient.” In this respect, claim 35 is akin to claim 1, which includes a similar limitation. Therefore, claim 35 is patentable over Botham for at least some of the same reasons that have been discussed above in relation to claim 1.

#### Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicant's representative, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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